



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,618	05/18/2004	James M. Murphy	PU2221	3617
23454	7590	04/04/2005	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/709,618

Applicant(s)

MURPHY ET AL.

Examiner

Alvin A. Hunter

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3711

DETAILED ACTION

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Application No. 10/247742 does not have the same disclosure and is related to a totally different invention.

Specification

The abstract of the disclosure is objected to because abstract is longer than 150 words. Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3711

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6491592. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent 6491592 claims the same subject matter except for the thickness of the return portion. One having ordinary skill in the art would have known the return portion has a thickness, and would have found it obvious to have the return portion of any thickness in order to receiver the aft body of the club head.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6471604. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent 6471604 discloses the same subject matter except for the same striking face and return portion thicknesses. Though the thickness are not exactly the same, US Patent No 6471604 is within the thickness ranges of the instant application and therefore anticipates the instant application.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6565452. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent No. 6565452 claim the same subject matter except for exact same extension length of the return portion. The instant application does not claim an upper range to the extension length of the return portion whereas US

Art Unit: 3711

Patent No. 6565452 claims the upper limit to be 1.5 inches, therefore, U.S. Patent No. 6565452 anticipates the instant application.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6582323. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application does not claim the particular material for the aft body. U.S. Patent claims the same subject matter except for the aft body being made of a composite material, which is a non-metal material. Therefore, U.S. Patent No. 6582323 anticipates the instant application.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6739982. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6739982 does not explicitly claim the return portion having an upper and lower lateral section. One having ordinary skill in the art would have drawn from the claims of U.S. Patent No. 6739982 that the return portion would have upper and lower lateral sections because the return portion extends from the perimeter of the striking face as set forth in claims 1, 10, and 11. Therefore, U.S. Patent No. 6739982 anticipates the instant application.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-39 of U.S. Patent No. 6739983. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6739983 does not explicitly claim the

Art Unit: 3711

return portion having an upper and lower lateral section. One having ordinary skill in the art would have drawn from the claims of U.S. Patent No. 6739983 that the return portion would have upper and lower lateral sections because the return portion extends from the perimeter of the striking face as set forth in claims 23 and 31. Therefore, U.S. Patent No. 6739983 anticipates the instant application.

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6758763. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6758763 does not explicitly claim the return portion having an upper and lower lateral section. One having ordinary skill in the art would have drawn from the claims of U.S. Patent No. 6758763 that the return portion would have upper and lower lateral sections because the return portion extends from the perimeter of the striking face as set forth in claims 1 and 10. Therefore, U.S. Patent No. 6758763 anticipates the instant application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone

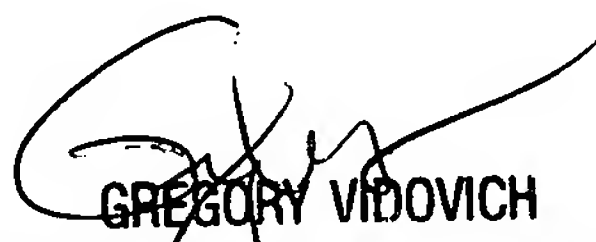
Art Unit: 3711

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



GREGORY VIDOVIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700